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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,845	09/20/2001	Andrew Victor Graham Muir	Q64774	2482

7590 03/13/2003

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EXAMINER

ZITOMER, FRED

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/13/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,845

Applicant(s)

MUIR ET AL.

Examiner

Fred Zitomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-72 is/are pending in the application.
- 4a) Of the above claim(s) 33-36, 39-63 and 66-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 32, 37, 38, 64 and 65 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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1.

At the outset it is noted that Group I in the restriction requirement of the prior Office action contains claims 32-43 and 62-67 not claims 33-43 as stated in the response of Paper No. 9. Applicant's election with traverse of Group I, claims 32-43 and 62-67, and the elected species set forth in Paper No. 9 are acknowledged. The traversal is on the grounds that Bowers and Sulc fail to disclose monomers wherein instant component R⁴ is aromatic. This is not found persuasive because as noted below copolymers useful for optical articles comprising all of the instant monomer units are known in the prior art.

The requirement is still deemed proper and is therefore made FINAL.

Contrary to applicant's assertion claims 32, 37, 38, 64 and 65 read on the elected species and are being examined at this time.

2.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32, 37, 38, 64 and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32: subscript "q", four occurrences, in component b) is not defined. It appears that "q" is mistakenly recited as "p" at the penultimate line.

3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

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obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sulc et al., US 5,270,415, taken with Namdaran et al., US 5,290,892.

Sulc teaches copolymers comprising the instant zwitterion monomers including 2-(methacryloyloxy)ethyl-2'-(trimethylammonium)ethyl phosphate [column 3, lines 40-57] and crosslinking monomers including ethylene glycol dimethacrylate [column 4, lines 22-36]. The copolymers are useful for preparing contact lenses and implantable prostheses such as intraocular lenses [column 1, lines 7-11; column 5, lines 3-6]. Namdaran teaches high refractive index copolymers comprising the aromatic monomers of instant component b) including benzyl methacrylate [column 3, lines 10-51] and crosslinking monomers including ethylene glycol dimethacrylate [column 3, lines 52-61]. The copolymers are useful for preparing ophthalmic lenses including intraocular lenses of high refractive index, flexibility and transparency [column 2, lines 35-39]. Sulc differs from the claimed invention by lacking an aromatic group containing comonomer unit. It would have been obvious to add aromatic group containing comonomers to the copolymers of Sulc in the expectation of enhancing refractive index, flexibility and transparency because Namdaran teaches the embodiment for the same class of copolymers as Sulc.

4.

Claims 37, 38 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sulc

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et al., US 5270,415, and Namdaran et al., US 5,290,892, as applied to claims 32 and 65 above, and further in view of Toh et al., US 5,502,139.

Sulc and Namdaran differ from the claimed invention by lacking a crosslinking monomer of instant formula III wherein R^9 is aromatic. Toh teaches crosslinking agents of instant formula III wherein component R^9 may be either aliphatic or aromatic including polyethyleneglycol dimethacrylate and the di(meth)acrylate esters of bisphenol A [column 2, line 54 – column 3, line 5; claim 1]. The polymers of Toh are useful for preparing optical articles including ophthalmic lenses of increased refractive index [column 7, lines 21-38]. It would have been obvious to add an aromatic crosslinker to Sulc and Namdaran because Toh teaches the suitability of both aliphatic and aromatic crosslinkers in the same class of polymers.

5.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Freeman, US 6,416,550, teaches that (meth)acrylate monomers of instant component b), including benzyl acrylate, are the most preferred material for foldable acrylic components in intraocular lenses [column 3, line 39 – column 4, line 17].

6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Zitomer whose telephone number is (703) 308-2461. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 (before final) and (703) 872-9311 (after final).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



**FRED ZITOMER, PhD
PRIMARY EXAMINER
ART UNIT 1713**

Zitomer/fz
March 7, 2003